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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784;660	02/15/2001	M. Salahuddin Khan	N0084 US	2233

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Navigation Technologies Corporation  
Attention Patent Department  
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EXAMINER

NOLAN, DANIEL A

ART UNIT	PAPER NUMBER
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2654

DATE MAILED: 08/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/784,660

Applicant(s)

KHAN ET AL.

Examiner

Daniel A. Nolan

Art Unit

2654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18, 20 and 21 is/are allowed.
- 6) ☒ Claim(s) 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 14 July 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

(Note that this application has been included in **Art Unit 2654**, and that this AU number should be used in all future correspondence.)

### ***Drawings***

2. The corrected or substitute drawings were received on 14 July 2003. These drawings are acceptable and the objections are withdrawn as being satisfied.

### ***Response to Amendment***

3. The filing of 14 July 2003 was applied to the following effect:
  - The Abstract was replaced and that objection is withdrawn.
  - The Title has been changed and the objection is withdrawn.
  - The claims were changed as indicated and the objections are withdrawn as having been satisfied.

***Response to Arguments***

4. Applicant's argument filed 14 July 2003 have been fully considered but it is not persuasive. Claim 19 is the sole issue in this argument. The position of the Applicant is that the invention of Wakisaka et al is defined by the contents of memory at the time of processing. The position of the Examiner is that the rejection encompasses not only the contents of memory but also the information that is available to be loaded for processing.

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d at 1477. Anticipation of a patent claim requires a finding that the claim at issue "reads on" a prior art reference. See Titanium Metals Corp. v. Banner, 778 F.2d 775, 781, 227 USPQ 773, 778 (Fed. Cir. 1985). In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art. See id. at 781.

Therefore, with the invention the prior art of record and the invention of the immediate application both defining the same two dictionaries for selection, one being general and the other being specific to an area, the rejection is maintained.

***Claim Rejections - 35 USC § 102***

5. Claim 19 is rejected under 35 U.S.C. 102(a) as being anticipated by Wakisaka et al (U.S. Patent 6,112,174).

6. Regarding claim 19, Wakisaka et al (column 2 line 52) reads on the feature of a *positioning system that determines a current location of a vehicle;*

- Wakisaka et al (column 54-63) reads on the feature of *an automatic speech recognition system that matches data representations of words spoken by a user of the vehicle to a word list of data representations of spoken names of geographic features,*
- Wakisaka et al (AREA 1-n in figure 3b) reads on the feature that *the word list of data representations of spoken names of geographic features includes only a portion of all available data representations of spoken names of geographic features contained in a geographic database*  
... because, each AREA of Wakisaka et al changes nature depending on whether they are in use or not, the remaining dictionaries of Wakisaka et al (as in figure 3B) read on the feature that *a 1<sup>st</sup> portion of the word list of data representations of spoken names of geographic features (column 6 line 28) includes data representations of spoken names of geographic features selected without regard to proximity to the current location of the vehicle;*

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- When the vehicle is in the appropriate AREA, Wakisaka et al reads on the feature that *the word list of data representations of names of geographic features includes data representations of spoken names of geographic features selected based upon proximity to the current location of the vehicle.*

***Allowable Subject Matter***

7. Claims 1-18 and 20-21 are allowed.
8. The following is a statement of reasons for the indication of allowable subject matter:
  - The present invention is directed to ***building a dictionary of places anticipating a request that might be spoken while driving, the places being selected on the basis of closeness to the vehicle.***
  - The closest prior art of record Wakisaka et al operates to continually build speech dictionaries, basing replacement on recognition failure and using maps from location sets based on position rather than individual distance. Other close prior art of DeLorme et al, does select places within a distance of a route, but only to display location on a map or for presentation of site information.
  - Claims 1, 6, 12 and 20 each identify the uniquely distinct features of "*determining whether a distance from the current position of the vehicle to a position*"

*associated with a previous build of a speech recognition word list exceeds a threshold; and*

*(if the distance exceeds the threshold), forming a new speech recognition word list by adding names of geographic features located in proximity to the current position of the vehicle to a plurality of words that correspond to a collection of geographic features selected without regard to proximity to the current position of the vehicle.*"

- While the closest prior art together could disclose a mechanism of *determining distances between a place and a vehicle and using an appropriate dictionary*, the dissimilarities between the effort of collecting elements meeting criteria for display and using prepared data for speech recognition is sufficiently great that the prior art of record would fail to anticipate or render the above underlined limitations obvious.
- Claims 2-5, 7-11, 13-18 and 21 depend on claims that have been found to be allowable and so would they themselves be allowed as a consequence.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Daniel A. Nolan at telephone (703) 305-1368 whose normal business hours are Mon, Tue, Thu & Fri, from 7 AM to 5 PM.

If attempts to contact the examiner by telephone are unsuccessful, supervisor Richemond Dorvil can be reached at (703)305-9645.

The fax phone number for Technology Center 2600 is (703)872-9314. Label informal and draft communications as "DRAFT" or "PROPOSED", & designate formal



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communications as "EXPEDITED PROCEDURE". Formal response to this action may be faxed according to the above instructions,

or mailed to:                      Box AF  
   Commissioner of Patents and Trademarks  
   Washington, D.C. 20231

or hand-delivered to:          Crystal Park 2,  
   2121 Crystal Drive, Arlington, VA,  
   Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 Customer Service Office at telephone number (703) 306-0377.

Daniel A. Nolan  
Examiner  
Art Unit 2654

DAN/d  
July 28, 2003

  
Fichemond Dorvil  
Primary Examiner